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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/664,473

09/17/2003

Carey E. Garibay

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EXAMINER

AGWUMEZIE, CHARLES C

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

07/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/664,473	Applicant(s) GARIBAY ET AL.	
	Examiner Charlie C. Agwumezie	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-129 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-129 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/26/07 has been entered.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, 10-18, 67-76 and 120-129, are drawn to a method of maintaining digital records of software licenses, the digital records indicating rights associated with software licenses, upgrading and downgrading multiple software licenses in a batch mode, classified in class 705, subclass 59.
 - II. Claims 19-28, 29-38, and 96-105, are drawn to a method of maintaining digital records of software licenses, wherein the upgrade or downgrade selected from a list of possible upgrades or downgrades, the list including an intermediate version, classified in class 717, subclass 168.

- III. Claims 39-52, 53-66, and 106-119, are drawn to a method comprising under the control of software user, selecting a software license, automatically, obtaining a list of appropriate product versions for upgrade and downgrade of software licenses, classified in class 717, subclass 121.
- IV. Claims 77-86 and 87-95, are drawn to a license management system comprising a memory adapted to maintain a digital record of a software license, a processor adapted to allow the downgrading the software version, classified in class 717, subclass 122.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I, and II, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable (MPEP § 806.05 (c)). In the instant case, invention I has separate utility such as a method of maintaining digital records of software licenses, the digital records indicating rights associated with software licenses, upgrading and downgrading multiple software licenses in a batch mode. Invention II has separate utility such as a method of maintaining digital records of software licenses, wherein the upgrade or downgrade selected from a list of possible upgrades or downgrades, the list including an intermediate version. Furthermore the combination of group I and II, as claimed does not require the particulars of the subcombination as claimed because the upgrading or downgrading software in a batch mode could be accomplished or performed without necessary need for listing the various versions of the software.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

5. Inventions I, and III, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a method of maintaining digital records of software licenses, the digital records indicating rights associated with software licenses, upgrading and downgrading multiple software licenses in a batch mode. Invention III has separate utility such as a method comprising under the control of software user, selecting a software license, automatically, obtaining a list of appropriate product versions for upgrade and downgrade of software licenses.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

7. Inventions I, and IV, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a method of maintaining digital records of software licenses, the digital records indicating rights associated with software licenses, upgrading and downgrading multiple

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software licenses in a batch mode. Invention IV has separate utility such as a license management system comprising a memory adapted to maintain a digital record of a software license, a processor adapted to allow the downgrading the software version.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

9. Inventions II, and III, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention II has separate utility such as a method of maintaining digital records of software licenses, wherein the upgrade or downgrade selected from a list of possible upgrades or downgrades, the list including an intermediate version. Invention III has separate utility such as a method comprising under the control of software user, selecting a software license, automatically, obtaining a list of appropriate product versions for upgrade and downgrade of software licenses. MPEP § 806.05(d).

10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

11. Inventions II, and IV, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if

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they are shown to be separately usable. In the instant case, Invention II has separate utility such as a method of maintaining digital records of software licenses, wherein the upgrade or downgrade selected from a list of possible upgrades or downgrades, the list including an intermediate version. Invention IV has separate utility such as a license management system comprising a memory adapted to maintain a digital record of a software license, a processor adapted to allow the downgrading the software version. MPEP § 806.05(d).

12. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

13. Inventions III, and IV, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention III has separate utility such as a method comprising under the control of software user, selecting a software license, automatically, obtaining a list of appropriate product versions for upgrade and downgrade of software licenses. Invention IV has separate utility such as a license management system comprising a memory adapted to maintain a digital record of a software license, a processor adapted to allow the downgrading the software version. MPEP § 806.05(d).

14. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and

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because the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

15. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. §1.143).

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

17. Applicants are being afforded the courtesy of a written response due to the complexity of the case and the attorney's representation that phone election will not be possible because the applicants need to be contacted.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on **(571) 272 – 6779**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Charlie Lion Agwumezie
Patent Examiner
Art Unit 3621

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June 28, 2007



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